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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,997	12/16/1999	LOU W. WATKINS	4642	8340

7590

09/11/2002

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/11/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/464,997

Applicant(s)

WATKINS, LOU W.

Examiner

Katherine A. Bareford

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.
- Application Papers Claims 2-3, 6-7, 11 and 13-17 are canceled.

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on August 5, 2002 is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that the prior application of a CPA must be: (1) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, (2) a design application, or (3) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000. *See Changes to Application Examination and Provisional Application Practice*, interim rule, 65 *Fed. Reg.* 14865, 14872 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47, 52 (Apr. 11, 2000). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114. *See id.* at 14866, 1233 *Off. Gaz. Pat. Office* at 48.

--- Note that a previous CPA was filed in June of 2001.

--- The amendment filed August 5, 2002 has been received and entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, line 1, this claim (as amended on Jan. 23, 2002) depends from claim 2. However, claim 2 was canceled by the same amendment. As a result, the claim depends from a canceled claim. For the purposes of examination, the Examiner has treated the claim as depending from claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 8-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 380 163 A2 (hereinafter '163) in view of DE 2 803 708 (hereinafter '708).

'163 teaches a method of applying syntactic foam insulation to a length of pipe. Column 1, line 30 through column 4, line 10. An inner syntactic foam insulator and an outer protective cover are co-extruded around the length of pipe. Column 2, lines 2-20 and column 3, lines 5-45 and figures 3-4. The cover is rapidly solidified. Column 3, lines 35-45. This retains the foam in a desired shape about the length of pipe. Column 3, lines 35-45 and figures 3-4.

Claim 9: '163 teaches a method of applying syntactic foam insulation to a length of pipe. Column 1, line 30 through column 4, line 10. An inner syntactic foam insulator and an outer protective cover are co-extruded around the length of pipe. Column 2, lines 2-20 and column 3, lines 5-45 and figures 3-4. The cover is rapidly solidified. Column 3, lines 35-45. This retains the foam in a desired shape about the length of pipe. Column 3, lines 35-45 and figures 3-4.

'163 teaches all the features of these claims except (1) the thermoplastic resin and (2) the air cooling (claims 8 and 12).

However, '708 teaches a method of applying a foam insulation to a length of pipe. See the abstract. An inner foam insulating and an outer protective cover are co-extruded around a length of pipe. Abstract and figures 1-3. The layers retain a desired shape about the length of pipe. Abstract and figures 1-3. The cover layer is a thermoplastic. Abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '163 to use a thermoplastic cover layer as suggested by '708 with an expectation of desirable produced pipe, because '163 teaches forming a three layer pipe with an inner layer, a foam intermediate layer and an outer layer by extrusion, and '708 teaches that when forming a three layer pipe with an inner layer, a foam intermediate insulation layer, and an outer layer using a co-extrusion process, it is conventionally known to use a thermoplastic outer layer. It would further have been obvious to provide air cooling with an expectation of desirable solidification, because, at the least, if no other form of cooling was specifically used, the air contact after extrusion would allow the product to cool.

Art Unit: 1762

6. Claims 1, 8-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 380 163 A2 (hereinafter '163) in view of Japan 62-28222 (hereinafter '222).

'163 teaches a method of applying syntactic foam insulation to a length of pipe. Column 1, line 30 through column 4, line 10. An inner syntactic foam insulator and an outer protective cover are co-extruded around the length of pipe. Column 2, lines 2-20 and column 3, lines 5-45 and figures 3-4. The cover is rapidly solidified. Column 3, lines 35-45. This retains the foam in a desired shape about the length of pipe. Column 3, lines 35-45 and figures 3-4.

Claim 9: '163 teaches a method of applying syntactic foam insulation to a length of pipe. Column 1, line 30 through column 4, line 10. An inner syntactic foam insulator and an outer protective cover are co-extruded around the length of pipe. Column 2, lines 2-20 and column 3, lines 5-45 and figures 3-4. The cover is rapidly solidified. Column 3, lines 35-45. This retains the foam in a desired shape about the length of pipe. Column 3, lines 35-45 and figures 3-4.

'163 teaches all the features of these claims except (1) the thermoplastic resin and (2) the air cooling (claims 8 and 12).

However, '222 teaches a method of applying a foam insulation to a length of pipe. See the abstract. An inner foam insulating and an outer protective cover are co-extruded around a simultaneously extruded length of pipe. Abstract and figures 1-3. The layers retain a desired shape about the length of pipe. Abstract and figures 1-3. The cover layer is a thermoplastic. Abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '163 to use a thermoplastic cover layer as suggested by '222 with an expectation

Art Unit: 1762

of desirable produced pipe, because '163 teaches forming a three layer pipe with an inner layer, a foam intermediate layer and an outer layer by extrusion, and '222 teaches that when forming a three layer pipe with an inner layer, a foam intermediate insulation layer, and an outer layer using a co-extrusion process, it is conventionally known to use a thermoplastic outer layer. It would further have been obvious to provide air cooling with an expectation of desirable solidification, because, at the least, if no other form of cooling was specifically used, the air contact after extrusion would allow the product to cool.

7. Claims 4-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 380 163 A2 (hereinafter '163) in view of DE 2 803 708 (hereinafter '708) as applied to claims 1, 8-9 and 12 above, and further in view of Francis (US 4773448).

'163 in view of '708 teach all the features of these claims except the water bath cooling.

However, Francis teaches a method of making a plastic pipe with a hard outer shell and an inner foam layer. Column 2, lines 5-45. Francis teaches cooling the pipe with a water bath to solidify the pipe after extrusion. Column 2, lines 25-35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '163 in view of '708 to use water bath cooling as suggested by Francis with an expectation desirable quick cooling, because '163 in view of '708 teaches forming a multilayer pipe by extrusion and cooling, and Francis teaches that when forming a multilayer pipe by extrusion, it is conventionally known to desirably use a water bath to cool the extruded material.

Art Unit: 1762

8. Claims 4-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 380 163 A2 (hereinafter '163) in view of Japan 62-28222 (hereinafter '222) as applied to claims 1, 8-9 and 12 above, and further in view of Francis (US 4773448).

'163 in view of '222 teach all the features of these claims except the water bath cooling.

However, Francis teaches a method of making a plastic pipe with a hard outer shell and an inner foam layer. Column 2, lines 5-45. Francis teaches cooling the pipe with a water bath to solidify the pipe after extrusion. Column 2, lines 25-35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '163 in view of '222 to use water bath cooling as suggested by Francis with an expectation desirable quick cooling, because '163 in view of '222 teaches forming a multilayer pipe by extrusion and cooling, and Francis teaches that when forming a multilayer pipe by extrusion, it is conventionally known to desirably use a water bath to cool the extruded material.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 4-5, 8-10 and 12 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner has cited the references to '708 and '222 as both indicating the co-extrusion of ^{insulating} ~~insulating~~ foam intermediate layers and thermoplastic outer layers to form insulated pipes.


Conclusion

Art Unit: 1762

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on M-F(7:00-4:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KATHERINE A. BAREFORD
PRIMARY EXAMINER
GROUP 1100/700